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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,357	12/23/1999	SHINJI NABESHIMA	2406-3	7310

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EXAMINER
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BOCCIO, VINCENT F

ART UNIT	PAPER NUMBER
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2615

13

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/471,357

Applicant(s)

NABESHIMA ET AL.

Examiner

Vincent F. Boccio

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on Election.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-83 is/are pending in the application.
- 4a) Of the above claim(s) 1-9, 11-18, 21-58 and 65-83 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10, 19, 20 and 59-64 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>#6, 7, 10, 11, 12, 13</u> | 6) <input type="checkbox"/> Other: _____  |

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**DETAILED ACTION**

**ELECTION**

1. Applicant's election without traverse of Group IV, claims 10, 19-20 and 59-64 in Paper No. 8 is acknowledged.

**Drawings**

2. The drawings are objected to because.

{A} Fig. 46, INDEX 0, "Tc\_Tr < 10800", the examiner believes that it should be "Tc-Tr", rather than the underscore, because Tc is a value and Tr is another value, therefore, {Tc\_Tr}, cannot be a value.

The examiner believes that time Tc is subtracted from Tr and result is compared with "10800", to determine if Tc-Tr is less than 10800 to perform an operation or not.

Please correct or explain why the If statement constructed as such.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

**Claim Rejections - 35 USC § 103**

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c)

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and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 10, 19-20, 59-64, are rejected under 35 U.S.C. 103(a) as being unpatentable over Butler et al. (US 2002/0007493, FD 7/1997).

Regarding claims 10 and 19, Butler discloses and meets the limitations associated with a transmission device that transmits a stream including content data wherein the stream includes: instruction or data for changing the reproduction control content (triggered overlays based on time information to provide the overlays); by comparing recording environment information and reproduction environment information (page 4, col. 2 "Timing information indicates times, relative to the video stream, at which particular overlays should be displayed. Hyperlinks can be activated to override the specific timings.", wherein can be provided with respect to specific timings, with respect to a stream, wherein the stream can be from a local storage device, page 5, col. 2, lines 60-, "local storage ... DVD", therefore, the DVD timing information represents recording environment information or time information, with respect to overlay timing (page 4, col. 2, line 47-) to trigger the overlay or changing the control content during reproduction by comparing the {specific overlay times} with timing information associated with the DVD playback, thereby providing overlays triggered based on time information with respect to local playback timing, such as a DVD, wherein at page 4, col. 2, lines 48-, "The timing information indicate times ... at which particularly overlays should be displayed. Hyperlinks can be activated to override the specific timing."), wherein at page 5 col. 2, line 60-, "the movie might be provided on a DVD, with the overlays files being downloaded from an internet source.

It is noted, that Butler mentions page 1, "DBS", digital video, streams in digital and even MPEG, form, but, fails to particularly mention the utilizing the TRANSPORT STREAM format.

The examiner takes official notice that a transport stream such as a MPEG transport stream format is well known to those skilled in the art and further that the transport stream can carry additional content, such as HTML or other additional content, as is well known therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Butler by transmitting on a MPEG transport stream format, wherein the format is used in error prone transmission environments, as is well known to those skilled in the art.

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Furthermore, regarding claim 19, instructions or can be for playback of media, such as DVD, therefore reproduction, and further the data can be for non local reproduction or a received video stream or not applied to on reproduction or no local reproduction, just reception (page 4), rather than local reproduction.

Regarding claim 20, based on the combination as applied with, provides for two modes, local reproduction (DVD) with stream provided overlay (content data) or received stream (broadcast), with stream provided overlays (content data),

but, fails to particularly disclose wherein the stream includes a program/script which is different control content depending on whether the current mode is reception or is left in reproduction mode.

Butler further discloses that the user's device is a PC, having internet access capability (page 4, col. 1) and further handling HTML, but, fails to mention or describe wherein the stream includes a program/script.

The examiner takes official notice receiving script or program script, is well known, sometimes referred to as Dynamic HTML, provides for buttons, wherein CGI scripts can be used to process user entered information etc....., as is well known.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify the combination by providing and receiving program scripts, thru the transport stream, to allow for user entered information, questionnaire, purchasing etc., as is well known to those skilled in the art.

Claims 59 and 60 are analyzed and discussed with respect to the claims above, wherein the combination provides for a transmission device providing a transport stream with content data, represented by overlay being interactive control data wherein this content presented to user for a DVD for example, is provided as interactive control data constituting a group of a plurality of interactive control data (page 4, col. 2, line 0047, "Hyperlink overlays can be provided in groups corresponding to a particular video stream"),

Furthermore, the limitation of being transmitted in repetitive fashion a plurality of times, is deemed met by the combination, upon a user or even multiple users, either utilizing a particular DVD program for local playback or receiving for multiple different users for the same program over time (weeks or months or even years), the content data would be provided in groups and further would be provided in a repetitive fashion, based on the frequency of different users receiving or even playing a particular program either received or from DVD,

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therefore, the content would be provided repetitively, obviously, as one skilled in the art would clearly understand.

Claim 61 is analyzed and disclosed with respect to the claims above.

Claim 62 is analyzed and disclosed with respect to the claims above, wherein as applied the combination fails to disclose wherein the control data including a portion that executes different control content in reception and reproduction.

The reference provides for reproduction and reception with overlays and further the overlay content is or can be triggered based on timing information relative to the stream.

The overlays are triggered based on the reproduction time or times, associated with trigger time or times, such that when a media is continuously reproduced, all overlays would be provided, as in the reception mode of operation.

Conversely, when skipping section with overlays, the overlays would also be skipped, therefore, a portion, {the portion skipped}, executes differently by not being provided in reproduction, rather than the reception mode which all overlays or content, are considered to be presented.

The examiner takes official notice that selective reproduction can be accomplished by a user, either by skipping sections or to have a route not including all the video sections, as is well known to those skilled in the art.

Therefore, it would have been obvious to one skilled in the art at the time of the invention to allow the user to skip a section or sections and therefore, the sections skipped with overlay, would not be provided or triggered or executes different control overlays, due to no corresponding time code to trigger one or more overlay by skipping sections of reproduction, as is obvious to those skilled in the art.

Please reference Fig. 46 of applicant's disclosure specifically index 0, and the If mode = reproduction.

Claim 63 is analyzed and discussed with respect to the claims above, but, claim 63, comprises an additional limitation such as "the service content including images for control purposes is restored in receiving mode.

As applied the combination meets the limitation if restoring images, met by the interactive user overlays, wherein according to Butler, page 4, col. 2, line 0049-, "one overlay can be temporarily overwritten by another. For example, an emergency news transmission have overlays that would

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overwrite a regularly scheduled show. When the emergency news transmission is completed, the previous overlays are restored, thereby meeting the limitation of restoring images for control purposed met by the interactive overlays presented to a user, first blocked or overwritten and then restored, wherein the emergency news could overwrite an overlay from either, a stream either reproduced or received modes of operation.

Claim 64 is analyzed and discussed with respect to the claims above.

Contact Fax Information

Any response to this action should be mailed to:  
Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communication intended for entry)

or:

(703) 308-5359, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Contact Information

1. Any inquiry concerning this communication or earlier communications should be directed to the examiner of record, Monday-Thursday, 8:00 AM to 5:00 PM Vincent F. Boccio (703) 306-3022.

If any attempts to reach the examiner by telephone are unsuccessful, the examiners supervisor, Andy Christensen (703) 308-9644.

Any inquiry of a general nature or relating to the status of this application should be directed to Customer Service (703) 306-0377.

Primary Examiner, Boccio, Vincent  
3/31/04

  
VINCENT BOCCIO  
PRIMARY EXAMINER